

## **REMARKS/ARGUMENTS**

Applicant acknowledges receipt of the Office Action dated December 1, 2006. Claims 1-10 and new claims 22-34 are pending in the application. The Office Action 1) requests that the Applicant affirm the provisional election to prosecute the invention of Group I, claims 1-10; 2) finds the declaration to be defective; 3) objects to the drawings under 37 C.F.R. 1.84(p)(5) because they include a reference character not mentioned in the Specification; 4) objects to claim 5 because it states that it depends upon itself; 5) rejects claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,066,904, issued to Rosenthal et al. ("*Rosenthal*"); and rejects claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Rosenthal* in view of U.S. Patent No. 5,895,378, issued to Berenstein et al. ("*Berenstein*"). Applicant believes all pending claims are allowable over the art of record and respectfully request reconsideration and allowance of all claims.

### **I. Affirmation of Provisional Election to Prosecute Group I, Claims 1-10**

Under 35 U.S.C. 121, Applicant is restricted to one of the following inventions: invention I, defined by claims 1-10 drawn to a catheter for providing an embolic material, and invention II, defined by claims 11-21 drawn to a method for treating a vascular malformation. During a telephone conversation with the Examiner on May 26, 2006, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-10, and to withdraw Group II, claims 11-21, from further consideration. Applicant hereby affirms the election to prosecute Group I and to withdraw Group II. However, Applicant reserves its right to file the withdrawn claims in a divisional application.

### **II. Declaration**

The Office Action states that the declaration is defective because it does not identify the mailing address of the inventor. Applicant respectfully suggests that the application data sheet identifies the inventor's mailing address, namely 6434 Auden, Houston, Texas 77005. Applicant is unclear what additional information is required in the declaration itself. The PTO/SB/01A (08-03) declaration form submitted in 2004 by Applicant did not require listing of the inventor's address in the declaration itself.

### **III. Drawings**

The Office Action objects to the drawings under 37 C.F.R. 1.84(p)(5) for including a reference character not mentioned in the description. Specifically, the Office Action states that Figure 4 discloses an element 14 that is not found in the Specification. In response, an amended replacement drawing sheet 2 depicting Figure 4 without an element 14, is included with this document. Applicant believes the amended replacement drawing sheet overcomes the Office Action's objection to the drawings and respectfully request withdrawal of the objection.

### **IV. Objection to Claim 5**

The Examiner objected to claim 5 because the claim depends upon itself. By this Response, claim 5 has been amended to depend from claim 2. Accordingly, Applicants believe this amendment addresses the Examiner's concerns and request withdrawal of the objection.

### **V. Claims 1-9 are patentable over *Rosenthal*.**

The Office Action rejects claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over *Rosenthal*. In order to establish a *prima facie* case of obviousness, the Office Action must satisfy the following three elements: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *MPEP* § 2143 (2005) (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). If just one of these elements is not met, the Office Action fails to establish a case of obviousness. Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness in rejecting claims 1-10.

*Rosenthal* teaches a method for delivering a drug to tissue at a desired location within the body using a hydrogel. *Rosenthal*, col. 1, lns. 47-48. The method includes release of a drug from hydrogel to a tissue at a desired location of the body using a balloon catheter. *Rosenthal*, col. 1, lns. 60-63. Delivery of the drug includes positioning the balloon at the point of desired drug application, expanding the balloon to engage the tissue, and infusing the triggering agent

into the hydrogel. *Rosenthal*, col. 2, lns. 15-19. When the triggering agent contacts the hydrogel, the drug is released. *Rosenthal*, col. 2, lns. 19-20.

Claim 1 is an independent claim upon which claims 2-9 depend. Claim 1 has been amended to include the limitations “wherein said at least one ring has an expanded size which occludes the space between the outer surface and the vessel,” “an injector configured to release embolic material proximate said distal end of said flexible tubular member and into the vessel,” and “wherein the embolic material and the at least one ring occlude the vessel.” *Rosenthal* does not teach or suggest any of these limitations. In the light of the foregoing, Applicant respectfully requests that the rejection be withdrawn and claims 1-9 be allowed.

**V. Claim 10 is patentable over *Rosenthal* in view of *Berenstein*.**

The Office Action rejects claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Rosenthal* in view of *Berenstein*. Applicant respectfully disagrees. Because independent claim 1 is not obvious in view of the prior art and because claim 10 depends from claim 1, claim 10 is allowable for the same reasons set out above. Accordingly, Applicant respectfully requests withdrawal of this rejection and allowance of the claim.

**VI. New Claims**

Applicant has added new claims 22-34 and respectfully suggests that these new claims are allowable.

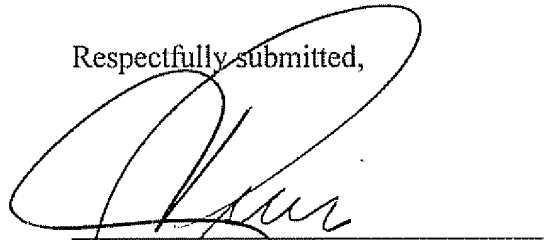
**VII. Conclusion**

In the course of the foregoing discussions, Applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which are yet to be raised, but which may be raised in the future.

Applicant believes that all claims are free of the prior art and are in condition for allowance. Entry of the amendments and allowance of all pending claims is respectfully requested. If the Examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore. If any fee is due, please appropriately charge such fee to Deposit Account Number 03-2769 of Conley Rose, P.C., Houston, Texas.

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to read 'J. Pierce', is written over a horizontal line.

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